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## REMARKS

Examiner Koch is thanked for the Office action, and for the interviews with Applicant on 2-22-2006. A separate summary of those interviews is being submitted.

Claims 1-12 and 19-24 are pending in the application. Applicant hereby cancels claims 1-8 and 11-12. Claim 9 is hereby amended to cure the 112 rejection, implementing Examiner Koch's suggestion in the final Office action. The rejections of claims 9 and 10 are traversed.

Claim 9 is also amended to implement the limitations of claim 8, from which it previously depended. This change does not add new limitations to claim 9, and only makes claim 9 an independent claim.

### Art Rejections

Pending claim 9, as currently amended, reads:

9. An automated mechanism to deposit textural paint onto a canvas comprising:

an attachment mechanism through which a canvas suitable for painting is held in place;

a deposition mechanism for depositing a selectable amount of paint through a well defined opening onto a canvas held by said attachment mechanism;

a motion control mechanism, attached to said deposition mechanism to move said deposition mechanism to a desired position with respect to the canvas; and

a control system which receives external data describing an amount of a given paint which is to be deposited at a pre-determined position onto the canvas and which controls said motion control system and paint deposition mechanism;

further comprising a painting implement attached to said motion control system to be used to redistribute paint on the canvas.

In rejecting claim 9, Examiner Koch has combined Ishida (which teaches a system that applies paste in any pattern to a substrate, including

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mechanisms to move the substrate and/or applicator with respect to one another) with McNeely (which teaches a bowling lane machine that one drives in a straight line down a bowling lane to apply a lane dressing compound).

Applicant respectfully submits that these two references, even if properly combined, would not teach all limitations of claim 9. Specifically, the last clause “further comprising a painting implement attached to said motion control system to be used to redistribute paint on the canvas,” is not taught or suggested in the cited references.

**1. The cited teachings of Ishida and McNeely cannot be properly combined in the manner suggested by Examiner.**

The brush of McNeely is not attached to the motion control mechanism of Ishida. Attaching the brush of McNeely would require substantial modification of either or both references. However, there is no teaching of whether or how to make such modifications. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting the combination. *In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987).

The motion control mechanism of Ishida involves a two-dimensional movement apparatus (15b and 15c) to move the substrate, and a one dimensional movement apparatus (15a) to move the nozzle for the paste. However, the brush of McNeely is designed to be moved along a single direction--longitudinally--down a bowling lane, to ensure even spread of the lane dressing compound. The apparatus of McNeely is also generally very different than that of Ishida, and used for rather different purpose (applying paste in a pattern versus spreading bowling lane dressing compound).

The mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) and also see *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) and *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993).

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Applicant therefore respectfully submits that there is no desirability to modify Ishida with the teaching of McNeely, and such modification is neither taught nor suggested in either reference--and is also undesirable in either reference. McNeely uses a very different apparatus than Ishida. Even if the brush of McNeely were somehow added to the apparatus of Ishida, it would only redistribute a substance by spreading it in only a single direction, and to cover the entire substrate (since McNeely shows the brush only being used to completely cover and blanket the bowling lane). Thus, the combination, even if proper, would not result in an apparatus that would fulfill the claimed limitation of, "a painting implement attached to said motion control system to be used to redistribute paint on the canvas," as claimed. This argument is discussed below.

**2. Even if properly combined, the cited references would not fulfill all claim limitations of claim 9.**

Applicant respectfully submits that the brush of McNeely is not a "painting implement" as that term is used in the claims and in the present specification. McNeely does not "paint" with it, as that term is used in the specification. Applicant notes that the terms in the claims are to be interpreted in light of the specification.

McNeely would not fulfill the claimed limitations because of its size in respect to the "substrate" (i.e., it covers the entire bowling lane in a single pass). McNeely's brush covers the entire substrate, namely, the lane of a bowling alley. McNeely's brush is used, "so that the compound is distributed during its forward movements." This does not fulfill the claimed limitation of, "a painting implement...to be used to redistribute paint on the canvas."

If the teaching of McNeely were combined with Ishida, the resulting apparatus would only be capable of spreading an even distribution of paint across the entire canvas, since McNeely's brush spans the width of the bowling lane. One of ordinary skill in the art, looking at McNeely's apparatus, would not find teaching or suggestion to modify McNeely to do otherwise.

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Painting is an intended use of the claimed apparatus, and it is respectfully that this use necessarily creates a distinction in the actual structure of the presently claimed apparatus with respect to the cited references. The brush of McNeely, because it covers the entire substrate (the width of the bowling lane) is not suitable for "painting", but only for blanket, uniform distribution of a substance over an entire area. The brush is not selective in how it can distribute paint or any substance. This results in a different structure in the present invention (for example, a paint brush, which would have a painting surface that is smaller than the width of the canvas) relative to the cited reference (a brush that covers the entire substrate, which could not be used in a "painting" application on a "canvas"). Because the recited use of painting results in a structure different from the cited reference, Applicant respectfully submits that the terms "deposit textural paint" should be read as a limitation in claim 9, as well as "redistribute paint on a canvas." These limitations, again, indicate structural differences with respect to the substrate-spanning brush of McNeely.

Applicant respectfully submits section 2111.02 of the MPEP, which states:

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part of the claimed invention). See also *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987). (The claim at issue was directed to a driver for setting a joint of a threaded collar\*>;< however>,<

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the body of the claim did not directly include the structure of the collar as part of the claimed article. The examiner did not consider the preamble, which did set forth the structure of the collar, as limiting the claim. The court found that the collar structure could not be ignored. While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver. "[T]he framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited." *Id.* at 1073, 828 F.2d at 754.).

Further, we respectfully submit that the preamble of claim 9, which recites depositing "textured paint" does result in a structural different with respect to the prior art. Specifically, the brush of McNeely is not capable of "painting" as that term is used in the specification and in the claim. McNeely's brush covers the entire substrate at a single stroke, and such a brush is incapable of "painting," since painting, as that term is used in the specification and the claims of the present application, includes selectively applying or redistributing the paint. A brush that covers an entire canvas would not be useful or desirable in the present inventions. The MPEP supports this position:

During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963)

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Applicant therefore respectfully submits that claim 9 and, by virtue of its dependence thereon, claim 10 are hereby distinguished from the cited reference. Favorable reconsideration of the claims is respectfully requested.

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**Conclusion**

Thus, all grounds of rejection and/or objection are traversed or accommodated, and favorable reconsideration and allowance are respectfully requested. The Examiner is requested to telephone the undersigned attorney or Robert Groover for an interview to resolve any remaining issues.

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Respectfully submitted,



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